UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/617,907	07/11/2003	Robert G. Wiley	61966-036 (SAET-008)	4895

7590 01/04/2005

David M. Mello
McDermott, Will & Emery
28 State Street
Boston, MA 02109

EXAMINER	
MEISLIN, DEBRA S	

ART UNIT	PAPER NUMBER
3723	

DATE MAILED: 01/04/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	10/617,907	WILEY, ROBERT G.	
	Examiner	Art Unit	
	Debra S Meislin	3723	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *09 August 2004*.

2a)☒ This action is **FINAL**. 2b)☐ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-10* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☒ Claim(s) *9-10* is/are allowed.

6)☒ Claim(s) *1-8* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☐ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____.
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: _____.

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

2. Claims 1-4 are rejected under 35 U.S.C. 102(b) as being clearly anticipated by Lin ('579).

The prior art structure of Lin is capable of performing the intended use of stripping an optical fiber. Note that the limitation "is of sufficient temperature and flow rate..." is dependent at least upon the workpiece structure and materials (e.g., thickness of coating) and the distance from the workpiece. Consequently, Lin would be capable of removing the coating without leaving residue in at least some instances depending upon the workpiece structure and materials and/or the distance from the workpiece.

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

4. Claim 5 is rejected under 35 U.S.C. 103(a) as being unpatentable over Lin in view of Dai et al ('389).

Lin discloses all of the claimed subject matter except for having a metal wire mesh filter. Dai et al discloses a filter formed of metal wire mesh. It would have been obvious to one having ordinary skill in the art to form the filter of Lin out of metal wire

mesh for its known properties and as such would have been an obvious mechanical equivalent as taught by Dai et al.

5. Claim 6 is rejected under 35 U.S.C. 103(a) as being unpatentable over Lin in view of Pollitt ('276).

Lin discloses all of the claimed subject matter except for having a cleaver. Pollitt discloses a wire stripping system including heated insulation severing elements, wire strippers, and wire cutter jaws/cleaver (96, 97). It would have been obvious to one having ordinary skill in the art to form the system of Lin with wire cutters/cleaver to allow for the wire to be cut at a selected location as taught by Pollitt.

6. Claims 7-8 are rejected under 35 U.S.C. 103(a) as being unpatentable over Lin in view of Vetrano ('856).

Lin discloses all of the claimed subject matter except for having an air source for generating an air burst and heat at about 700 degrees Celsius. Vetrano discloses an air source for generating an air burst and heat at about 700 degrees Celsius. It would have been obvious to one having ordinary skill in the art to form the device of Lin with an air source for generating an air burst to direct the heat to the workpiece as taught by Vetrano. It would have been obvious to one having ordinary skill in the art to form the device of Lin with heat at about 700 degrees Celsius to allow for the fiber to be stripped as taught by Vetrano.

7. Claims 9-10 are allowed. The following is an examiner's statement of reasons for allowance: The prior art of record fails to disclose at least one actuator operatively coupled to the stripper, that strips with a burst of hot air, and to the cleaver.

8. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

9. Applicant's arguments filed August 9, 2004 have been fully considered but they are not persuasive.

The rejection in view of Nakajima has been withdrawn as being cumulative in nature.

In response to applicant's argument that Lin does not suggest the purpose of stripping an optical fiber, a recitation of the intended use of the claimed invention must result in a structural difference between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art. If the prior art structure is capable of performing the intended use, then it meets the claim. In a claim drawn to a process of making, the intended use must result in a manipulative difference as compared to the prior art. See *In re Casey*, 152 USPQ 235 (CCPA 1967) and *In re Otto*, 136 USPQ 458, 459 (CCPA 1963). The prior art structure of Lin is capable of performing the intended use of stripping an optical fiber.

Note that the limitation in claim 1 "is of sufficient temperature and flow rate..." is dependent at least upon the workpiece structure and materials (e.g., thickness of coating) and the distance from the workpiece. Consequently, Lin would be capable of

removing the coating without leaving residue in at least some instances depending upon the workpiece structure and materials and/or the distance from the workpiece.

Applicant contends, on page 6, that there are no devices for stripping optical fiber with a burst of heat. Vetrano discloses a device for stripping optical fiber with a burst of heat.

With respect to the teaching of Dai et al, Dai et al was applied to the rejection of the claims to teach only the concept of forming a filter out of metal wire mesh as opposed to Lin's ceramic material and not for the structure disclosed by Lin.

Lin and Pollitt both disclose devices for thermally stripping wire and are thus considered analogous. Pollitt was not applied to the rejection of the claims to teach the stripping of optical wires. Pollitt was applied to the rejection of the claims to teach only the concept of providing a thermal stripping device with a cleaver. In response to applicant's argument that there is no suggestion to combine the references, the examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988)and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992). In this case, motivation to do so is found in the references themselves. It would have been obvious to form the system of Lin with wire cutters/cleaver to allow for the wire to be cut at a selected location as taught by Pollitt.

Lin and Vetrano both disclose devices using hot gas for use on a workpiece are thus considered analogous. The claims do not preclude the additional structure shown in Vetrano. Motivation to combine Lin and Vetrano is found in the references themselves. It would have been obvious to form the device of Lin with an air source for generating an air burst to direct the heat to the workpiece as taught by Vetrano. It would have been obvious to form the device of Lin with heat at about 700 degrees Celsius to allow for the fiber to be stripped as taught by Vetrano.

10. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Debra S Meislin whose telephone number is 571 272-4487. The examiner can normally be reached on M-F, alt. Fridays off.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Joseph Hail can be reached on 571 272-4485. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Debra S Meislin
Primary Examiner
Art Unit 3723

December 13, 2004